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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/594,181

11/27/2007

David G. Burton

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WOODARD, EMHARDT, MORIARTY, MCNETT & HENRY LLP
111 MONUMENT CIRCLE, SUITE 3700
INDIANAPOLIS, IN 46204-5137

EXAMINER

KENNEDY, JOSHUA T

ART UNIT

PAPER NUMBER

3679

NOTIFICATION DATE

DELIVERY MODE

12/09/2009

ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

DocketDept@uspatent.com

Advisory Action Before the Filing of an Appeal Brief	Application No. 10/594,181	Applicant(s) BURTON ET AL.	
	Examiner JOSHUA T. KENNEDY	Art Unit 3679	

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 09 October 2009 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.
 b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☐ The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☐ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
 (a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);
 (b) ☐ They raise the issue of new matter (see NOTE below);
 (c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
 (d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
 5. ☐ Applicant's reply has overcome the following rejection(s): _____.
 6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
 7. ☒ For purposes of appeal, the proposed amendment(s): a) ☐ will not be entered, or b) ☒ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
 The status of the claim(s) is (or will be) as follows:
 Claim(s) allowed: _____.
 Claim(s) objected to: _____.
 Claim(s) rejected: 2-4 and 6-27.
 Claim(s) withdrawn from consideration: _____.

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
 9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing a good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
 10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because:
See Continuation Sheet.
 12. ☐ Note the attached Information *Disclosure Statement*(s). (PTO/SB/08) Paper No(s). _____.
 13. ☐ Other: _____.

/Daniel P. Stodola/
 Supervisory Patent Examiner, Art Unit 3679

/JTK/
 Examiner, Art Unit 3679

Continuation of 11. does NOT place the application in condition for allowance because: The applicant's arguments are not persuasive. It is first noted that all of applicant's claimed limitations are met by the prior art within the broadest reasonable interpretation of the claim language as has been previously advanced. Motivation to combine the references comes from knowledge generally available to one of ordinary skill in the art and the references themselves. Lastly, the Supreme Court has consistently held that where all of the pieces of the invention are known in the prior art it is not patentable to combine known pieces, even to produce beneficial results, unless those results are unexpected and unpredictable. That is to say that if cogent reasoning, based in no part upon hindsight, demonstrates predictability of the new result, a patent will not issue. See *In Re Hotchkiss v. Greenwood*, 52 U.S. 248, which stated that even beneficial results of being "made firm and strong, and more durable" do not render an invention patentable over the prior art if those results are predictable; see also *In re KSR International Co. v. Teleflex Inc.*, 82 USPQ2d 1385 (U.S. 2007), which states "[T]he results of ordinary innovation are not the subject of exclusive rights under the patent laws. Were it otherwise patents might stifle, rather than promote, the progress of useful arts. See U.S. Const., Art. I, section 8, cl.8."

Applicants argue:

"Johnson's item 25 is a 'distal section..., which is generally tubular shaped with little taper' (col. 2, lines 53-54). In other Figures, item 25 does not have a taper, while in Figure 5 it starts from an outer cylindrical diameter of item 12/112, extending outward and abutting 'lock nut receiving section 24' of the same outer cylindrical diameter of item 12/112. Thus, to the extent Johnson section 25 has any taper, it widens from the otherwise uniform outer diameter of item 12/112 to a maximum diameter, then steps back down to the uniform outer diameter at part 24a" (Page 9).

Examiner respectfully disagrees and notes that the taper of Johnson relied upon in the rejection is the tapered structure 25 as shown in Figures 6 and 7. In the Figures 1-4 this similar structure is denoted as "22". As described in the specification and set forth in the final rejection this tapered section guides and facilitates a snap fit connection of the luer fitting member (6) into a locking member (2). It appears as if the basis for Applicants arguments is founded on the embodiment of Figures 1-4 instead of Figures 5-7 on the structure 60 as shown in Figures 6-7. Examiner clarifies that the tapered structure relied upon in the rejection is based on the tapered section 22 as shown in Figures 1-4 and the similar tapered structure 25 as shown in Figures 5-7.

Applicants further argue;

"Moreover, the references' goals are opposed to each other. As noted above, Guala teaches that twisting force generated by turning item 2 with respect to item 6 is to be avoided (column 1, lines 21-32). Guala's objective is to provide parts that rotate with respect to each other around an axis, without binding or twisting each other. Johnson, on the contrary, focuses on locking to prevent relative twisting or turning of its parts. Johnson teaches a locking ring 16 that firmly and unrotatably fits on a male luer connector via engagement of teeth 42 and 23a, and also prevents rotation between itself and lock nut 14 via engagement of teeth 46 and 35a. When assembled as in Fig. 3, items 14, 16 and 12 are prevented from turning with respect to each other, accomplishing the goal of preventing twisting and loosening among these parts (see, e.g., column 1, lines 25-31)" (Page 10).

Examiner respectfully disagrees and again points out that the Examiner solely relies upon Johnson to teach the tapered structure 22 as shown in Figures 1-4 and the similar tapered structure 25 as shown in Figures 5-7.

Applicants further argue:

"It is also noted that not all elements of the claims are found in the references. For example, with due respect the Guala reference does not show a 'one-piece locking member' as recited. Rather, Guala identifies that two pieces lock its item 6 with a male luer connector. At column 2, lines 28-35, Guala explains that a male luer connector with some internally-threaded member is connected to Guala's item 1. The male luer connector is inserted into item 6, and its associated internally-threaded member threads onto thread 5 of item 2. The connection between the male luer connector and item 6 is thus locked with two pieces, item 2 and the threaded item associated with the male luer connector" (Page 11).

Examiner respectfully disagrees and notes that, as set forth in the final rejection, Examiner considers the male luer member to be item 6. This is further emphasized in Col 2, Lines 32-33 when item 6 is described as "the Luer cone". Therefore the Guala reference does show a one-piece locking member (2) as is required by the claim language.

As to the arguments presented regarding the "finlike" and "skeletal" language:

These arguments are not persuasive for the reasons previously advanced on pages 9-11 of the final rejection. Further, Examiner notes that a "rectangular flat" is "finlike" inasmuch as any of the "finlike" handles disclosed in the instant disclosure.

As to the arguments regarding Claim 8:

Examiner notes that there was a typographical error by not including Johnson in combination with Guala. Regardless, the Courts have made clear that the teaching, suggestion, or motivation test is flexible and an explicit suggestion to combine the prior art is not necessary. The motivation to combine may be implicit and may be found in the knowledge of one of ordinary skill in the art, or, in some cases, from the nature of the problem to be solved. *Id.* at 1366, 80 USPQ2d at 1649. "[A]n implicit motivation to combine exists not only when a suggestion may be gleaned from the prior art as a whole, but when the improvement is technology-independent and the combination of references results in a product or process that is more desirable, for example because it is stronger, cheaper, cleaner, faster, lighter, smaller, more durable, or more efficient. Because the desire to enhance commercial opportunities by improving a product or process is universal-and even common-sensical- we have held that there exists in these situations a motivation to combine prior art references even absent any hint of suggestion in the references themselves. In such situations, the proper question is whether the ordinary artisan possesses knowledge and skills rendering him capable of combining the prior art references." *Id.* at 1368, 80 USPQ2d at 1651. In this case, it is clearly shown that Werschmidt shows a similar connection member familiar to one of ordinary skill and that the reference discloses the claimed undulating grip

comprising 10 waves as is shown in Figure 4 of the reference.